

Appl. No. 10/065,869
Docket No. 128653/GEM-0068

REMARKS / ARGUMENTS

Status of Claims

Claims 1-28 are pending in the application. Claims 1, 3-5, 7, 8, 11, 13-15, 17, 18, 21, 23-25, 27 and 28 stand rejected. Claims 2, 6, 9, 10, 12, 16, 19, 20, 22 and 26 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's acknowledgement regarding the allowability of the noted claims. Applicant has amended Claims 3-4, 7-8, 13-14, 17-18, 21, 23-25 and 27-28, leaving Claims 1-28 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(e) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Claim Objections

Claims 3-4, 7-8, 13-14, 17-18, 23-24 and 27-28, are objected to under 37 CFR 1.75(c) for reasons relating to a failure to further limit the subject matter of a previous claim.

Applicant traverses this objection for the following reasons.

Claims 3, 7, 13, 17, 23 and 27, each include the limitation of:

...a *second* plurality of secondary images taken in planes orthogonal to the first plane...

Claims 4, 8, 14, 18, 24 and 28, each include the limitation of:

...associating the label to a *second* point in the primary image...

Here, Applicant emphasizes the word "*second*", which is not presented in the previous respective claim. As such, Applicant submits that Claims 3-4, 7-8, 13-14, 17-18, 23-24 and 27-28 do in fact limit the subject matter of the previous respective claim, and therefor do comply with 37 CFR 1.75(c).

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However, in an effort to further this application to allowance, Applicant has, without a narrowing of the scope of the claims, amended the subject claims to further highlight the word "second". No new matter has been added as antecedent support may be found in the application as originally filed, such as at Paragraph [0020], for example.

These claims have not been amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicant is entitled has been surrendered.

In view of the foregoing, Applicant submits that this objection has been overcome, and respectfully requests reconsideration and withdrawal thereof.

Rejections Under 35 U.S.C. §102(e)

Claims 1, 3-5, 7-8, 11, 13-15, 17-18, 21, 23-25 and 27-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Wahl et al. (U.S. Patent No. 6,359,960, hereinafter Wahl).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Independent Claims 1, 5, 11, and 15 recite, inter alia:

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"...identifying *a primary image taken in a first plane*;
identifying a plurality of secondary images taken in planes *orthogonal to the first plane*;...".

Independent Claims 21 and 25 have been amended to recite, inter alia:

"...an imaging device configured to provide a primary image and a plurality of secondary images of the target body, *the primary image being taken at a first plane* through the target body and the secondary images being taken at second planes through the target body and *orthogonal to the first plane*;...".

Dependent claims inherit all of the limitations of the respective parent claim.

Here, Applicant specifically claims *a first plane* and a plurality of secondary images taken in planes *orthogonal to the first plane*.

The Examiner alleges that Whal discloses each and every element of the claimed invention arranged as claimed, but does not state with specificity where Whal discloses the claimed *first plane* and plurality of secondary images taken in planes *orthogonal to the first plane*.

More specifically, the Examiner alleges anticipation of the above-noted claim elements by stating "Whal teaches... identifying a plurality of secondary images taken in planes orthogonal to the first plane (see figure 1 and col. 4 lines 14-22; note 3D volume data set acquired from the series of 2D projections; also see figure 2 for plurality of 2D projection planes denoted at P1-P4)...". Paper No. 0306, pages 2-3.

Applicant respectfully disagrees.

At Figure 1, Applicant finds Whal to disclose an X-ray source 2 and a detector 3 that move around an orbit K (col. 3 line 65 - col. 4 line 2).

At col. 4 lines 14-22 and at Figure 2, Applicant finds Whal to disclose a series of 2D projections and a plurality of projection planes denoted as P1-P4.

However, and contrary to the Examiner's allegation, Applicant does not find Whal to disclose *a first plane* and plurality of secondary images taken in planes *orthogonal to the first plane*.

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In comparing Whal with the claimed invention, Applicant finds Whal to disclose "2D projections P1 through P4... which have been picked up under *different projection angles* by means of the X-ray system..." (col. 4, lines 47-51) (emphasis added), and to be absent any disclosure of *a first plane* and a plurality of secondary images taken in planes *orthogonal to the first plane*.

Applicant respectfully submits that the "*different projection angles*" of Whal is not the same as *a plurality of planes orthogonal to a first plane*.

Accordingly, Applicant submits that Whal does not disclose all of the claimed elements arranged as in the claim, and absent anticipatory disclosure in Whal of each and every element of the claimed invention arranged as in the claim, Whal cannot be anticipatory.

In view of the foregoing remarks, Applicant submits that Whal does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(e) has been traversed, and requests that the Examiner reconsider and withdraw this rejection.

The arguments and amendments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims have not been amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicant is entitled has been surrendered. Allowance of the claims is respectfully requested in view of the above remarks. Moreover, no amendments as presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit account 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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